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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,064	09/13/2000	Donald Eugene Brodnick	GEMS8081.040	7626

27061 7590 09/09/2004

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EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT PAPER NUMBER

3762

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/661,064	BRODNICK ET AL.	
	Examiner	Art Unit	
	George R Evanisko	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-61 is/are pending in the application.
- 4a) Of the above claim(s) 52-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-39 and 43-51 is/are rejected.
- 7) ☒ Claim(s) 40-42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/7/04 has been entered.

Election/Restrictions

Claims 52-61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/8/04.

Applicant's election with traverse of the restriction in the reply filed on 7/8/04 is acknowledged. The traversal is on the ground(s) that the three way requirement has not been met. The argument that the first requirement is not met because there is a three word distinction between claims 37 and 52 where "the combination as claimed does not require the particulars of the subcombination as claimed for patentability" is not persuasive. Claim 52 does not contain those three words and since those three words will need to be located in the prior art to determine if claim 37 is patentable, the first requirement is met. The argument that during the previous examination the 12 lead ECG data would be obvious, and therefore not patentable, over the art of record and therefore there is no patentable distinction is not persuasive. The previous rejection was based on claims 1 and 36 and not new claims 37 and 52. In addition, that argument provides evidence that the 12 lead ECG data is required for patentability since a rejection was

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needed/made concerning that particular claim limitation. The argument that the second requirement for restriction is not met is not persuasive. Claim 52 requires a second ECG device/monitor providing the ECG signals in human discernable form. Claim 37 does not require a second ECG device and can operate as a stand alone unit with only one ECG device. Therefore the second requirement is met. The argument that the third requirement is not met because Group I and Group II should each be classified into the class and subclasses identified by the Examiner is not persuasive because the examiner has indicated that the groups are classified into different subclasses. In addition, although the groups may have similar classes, the entire search for each of the groups does not entirely overlap. Therefore the third requirement is met.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 48 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter which was not described in the original specification is the apparatus operating "on-demand from the patient".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 45 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 44 and 45, "through a" global computer system or EM wave is vague since it can not be determined if the system or wave is being positively recited. The examiner has interpreted the claims as being "adapted to be transmitted" through the system or wave.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 37, 38, 47-49, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bornn (5564429).

Bornn discloses the claimed invention including a portable device (column 8), a cellular/wireless device/phone (column 8), processor, 1006, memory, 1008 or the memory shown in figure 5 located under the microprocessor, connected to data link port (the arrow shown in figure 3A between 1006 and 1008 or the arrow shown in figure 5), and using different configurations of electrodes (column 9) except for the specific 12 lead wire assembly and processing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the ECG monitoring system as taught by Bornn, with a 12 lead wire assembly and processing since it was known in the art that ECG monitoring systems use 12 lead wire assemblies and processing to provide a complete and easily readable ECG data record for determining cardiac conditions and for allowing more accurate diagnoses of patient conditions.

Claims 39 and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bornn.

Bornn discloses the claimed invention and using video, audio, and ECG data over phone lines in column 12 (the device is therefore an interactive internet appliance since the applicants specification on page 8 states that an "internet appliance is any device capable of transmitting such data over an interconnected communication system").

In the alternative, Bornn does not disclose the wireless interface being an interactive internet TV appliance allowing voice, video, and ECG transmission concurrently (claims 39 and 43), having a microphone and video camera (claims 43), using an interconnected global communication system or EM waves (claims 44 and 45), and using infrared transmitters and receivers to communicate between the appliance and interface (claim 46). It would have been

obvious to one having ordinary skill in the art at the time the invention was made to modify the remote monitoring ECG system as taught by Bornn, with the wireless interface being an the wireless interface being an interactive internet TV appliance allowing voice, video, and ECG transmission concurrently (claim 39), having a microphone and video camera (claims 43), using an interconnected global communication system or EM waves (claims 44 and 45), and using infrared transmitters and receivers to communicate between the appliance and interface (claim 46) since it was known in the art that remote monitoring ECG systems use: the wireless interface being an interactive internet TV appliance using video cameras and microphones and allowing voice, video, and ECG transmission concurrently as a way to easily and quickly transfer large amounts of voice, video, and data concurrently over existing communication networks and provide the patient and physician with pictures and sound of each other to provide a more comfortable atmosphere for the patient and allow the doctor to more easily determine if anything is wrong with the patient; using an interconnected global communication system or EM waves for transferring the audio and video data since they are widely available, conventional, and inexpensive ways to transfer the data; and that remote monitoring ECG systems use infrared transmitters and receivers to communicate between different elements to provide ease of use of monitors for transmission of data over short distances without the burden of transmission lines/cables potentially getting tangled.

Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bornn in view of Morgan et al (5782878).

Bornn discloses the claimed invention except for a GPS system connected to the communication interface and being enabled by the processor when a signal is received by the

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healthcare provider. Morgan teaches that it is known to have a GPS system connected to the communication interface to allow the remote determination of the location of a patient by the health care provider. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the monitoring system as taught by Bornn, with a GPS system connected to the communication interface as taught by Morgan, since such a modification would provide an monitoring system with a GPS system connected to the communication interface to allow the remote determination of the location of a patient by the health care provider to find the patient in case of emergency. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the monitoring system as taught by Bornn in view of Morgan, with the GPS system being enabled by the processor when a signal is received by the healthcare provider since it was known in the art that monitoring GPS systems are programmed to allow the processor to enable the GPS system by a signal from the healthcare provider to allow the provider to enable the GPS system to locate a patient when the patient is distressed and unable to communicate his/her location.

Allowable Subject Matter

Claims 40-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612.

The examiner can normally be reached on M-F 6:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


George R Evanisko
Primary Examiner
Art Unit 3762

9/6/4

GRE
September 6, 2004